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Legal Department, DL429
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ATTORNEY DOCKET NO. 10010565-2

TPW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Richard P. Tella, et al.

Serial No.: 10/630,490

Examiner: Lyle Alexander

Filing Date: July 29, 2003

Group Art Unit: 1743

Title: Apparatus and Methods for Printing Arrays

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ☒ Response/Amendment ☐ Petition to extend time to respond
☐ New fee as calculated below ☐ Supplemental Declaration
☒ No additional fee (Address envelope to "Mail Stop Amendments")
☐ Other: (Fee \$ _____)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X 50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X 200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ 360	\$ 0
EXTENSION FEE	1 ST MONTH 120.00 <input type="checkbox"/>	2 ND MONTH 450.00 <input type="checkbox"/>	3 RD MONTH 1020.00 <input type="checkbox"/>	4 TH MONTH 1590.00 <input type="checkbox"/>		\$ 0
OTHER FEES						\$ 0
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-1078 pursuant to 37 CFR 1.2 5. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,
Richard P. Tella, et al.

By Theodore J. Leitereg
Theodore J. Leitereg
Attorney/Agent for Applicant(s)

I hereby certify that this correspondence is being Deposited with the United States Postal Service as First class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: October 27, 2006

Typed Name: Theodore J. Leitereg

Signature: Theodore J. Leitereg

Reg. No. 28,319

Date: October 27, 2006

Telephone No. 408-553-2510



CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on October 27, 2006.

Signature Theodore J. Leitereg Date 10/27/06
Name: Theodore J. Leitereg

PATENTS
Attorney Docket No. 10010565-2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Richard P. Tella, *et al.*

Serial No. 10/630,490

Group Art Unit: 1743

Confirmation No.: 9682

Examiner: Lyle Alexander

Filed: July 29, 2003

Title: Apparatus and Methods for Printing Arrays

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Response to Restriction Requirement

This paper is responsive to the Restriction Requirement in the Office Action dated October 4, 2006, from the U.S. Patent and Trademark Office in the above-identified patent application.

Restriction Requirement

Restriction was required under 35 U.S.C. §121 as follows:

Group I – Claims 1-8 and 26-36, drawn to a method and apparatus for biopolymer synthesis, classified in class 436, subclass 89.

Group II – Claims 10-25 and 46-47, drawn to a dispensing apparatus comprising additional loading moving and washing stations, classified in class 106.

Group III – Claims 37-43 and 45, drawn to a method and apparatus of washing a droplet dispensing nozzle, classified in class 436, subclass 49.

Group IV – Claim 44, drawn to an apparatus for loading reagents into a dispensing device, classified in class 106.

In making the Restriction Requirement, a determination was made that the inventions of Groups I, II, III, IV and V are distinct each from the other. According to M.P.E.P. 802.01 the term “distinct” means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (emphasis in original). Accordingly, in making the restriction requirement the Office Action is acknowledging at least implicitly that the inventions of the aforementioned groups are separately patentable over one other. If this were not the case, then the restriction requirement would not be proper. The Office Action indicated that the subcombinations were not obvious variants.

Furthermore, it follows from the above that art (if such art exists) that discloses no more than the subject matter of the claims of one of the above groups, i.e., subcombinations, cannot render known or obvious the invention of the other groups. If this were not the case, then the restriction requirement with respect to those claims would not be proper.

Applicant recognizes that the M.P.E.P. does state, “though they may each be unpatentable because of the prior art.” However, this language must only mean that there may be art that renders one of the inventions unpatentable and other art that renders another of the inventions unpatentable. The language cannot mean that art disclosing no more than the subject matter of the claims of one of the groups and anticipating or rendering obvious the invention of that group would also anticipate or render obvious the inventions of the other group. If so, then the inventions of the separate groups would not be patentable over one another and the restriction requirement would be improper.

In response to and as required by the Restriction Requirement, Applicant elects the invention of Group I, Claims 1-8 and 26-36. Applicant reserves the right to file divisional patent applications to the subject matter that the Office Action has determined to be patentably distinct and separately patentable.

Claim 9

Applicant notes that claim 9 was not included in any of the above groups. Applicant respectfully requests clarification and an opportunity to respond to any additional restriction requirement.

Subcombinations

The Office Action noted that restriction was required between subcombinations usable together and that, where applicant elects a subcombination and claims thereto are subsequently found allowable, any claims depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with the provisions of M.P.E.P. §821.04.

The Office Action also advised that, if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

There is one caveat to the above statement in the Office Action. According to the above-cited section of the M.P.E.P., the restriction requirement in the parent application must be withdrawn. Otherwise, the claims in the aforementioned groups are separately patentable over each other as indicated in the Restriction Requirement.

Respectfully submitted,


Theodore J. Leitereg
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